

### REMARKS

#### *The Present Invention and the Pending Claims*

The present invention pertains to feed rations and human food products comprising corn meal obtained after extraction from whole high oil corn. Claims 1-25 and 73 are currently pending.

#### *Amendments to the Specification*

The specification has been amended to correct informal and inadvertent mistakes without adding new matter. Specifically, page 18, line 14 of the specification is being revised to add reference to AOCS Method Cc 13b-45. Page 22, line 4 is being amended because the city of Hutchinson, Minnesota was inadvertently misspelled. Page 27, line 5 and page 35, line 2 are being amended to correctly identify AOCS method Ba 3-38, which was inadvertently labeled AOCS method 3-38.

#### *Summary of the Office Action*

The Examiner has removed the requirement for an election of species.

Claims 1-6, 8-17, and 19-25 stand rejected under the judicially created doctrine of obviousness-type double patenting, as allegedly obvious over copending U.S. Patent Application No. 09/927,836, optionally in view of Morrison (Feeds and Feeding: A Handbook for the Student and Stockman, 22<sup>nd</sup> Ed., The Morrison Publishing Co.: Ithaca, NY (1957)).

Claims 1-25 and 73 stand rejected under 35 U.S.C § 103(a), as allegedly obvious over copending U.S. Patent Application No. 09/927,836.

Claims 1-6, 8-16, and 19-25 stand rejected under the judicially created doctrine of obviousness-type double patenting, as allegedly obvious over copending U.S. Patent Application No. 10/422,295 in view of Morrison (Feeds and Feeding: A Handbook for the Student and Stockman, 22<sup>nd</sup> Ed., The Morrison Publishing Co.: Ithaca, NY (1957)).

Claims 1-25 and 73 stand rejected under 35 U.S.C § 103(a), as allegedly obvious over copending U.S. Patent Application No. 10/422,295.

Claims 1-6, 8-16, and 19-25 stand rejected under the judicially created doctrine of obviousness-type double patenting, as allegedly obvious over U.S. Patent No. 6,723,370 (Ulrich et al.) in view of Morrison (Feeds and Feeding: A Handbook for the Student and Stockman, 22<sup>nd</sup> Ed., The Morrison Publishing Co.: Ithaca, NY (1957)).

Claims 1-25 and 73 stand rejected under 35 U.S.C § 103(a), as allegedly obvious over U.S. Patent No. 6,723,370.

Claims 1-25 and 73 stand rejected under 35 U.S.C § 103(a), as allegedly obvious over Watson (Corn Chemistry and Technology, American Association of Cereal Chemists, Inc.: St. Paul, Minnesota (1994)) in view of Morrison (Feeds and Feeding: A Handbook for the Student and Stockman, 22<sup>nd</sup> Ed., The Morrison Publishing Co.: Ithaca, NY (1957)).

Reconsideration of the pending claims is respectfully requested.

*Discussion of the Double Patenting Rejections*

According to the Examiner, the claims in copending U.S. Patent Application Nos. 09/927,836 and 10/422,295 and U.S. Patent No. 6,723,370 are directed to a corn meal and a feed containing corn meal but differ from the claims of the instant application in that they lack the suggestion of the inclusion of another nutrient. The Examiner contends that the inclusion of another nutrient would be obvious in view of Morrison.

U.S. Patent Application No. 09/927,836 issued as U.S. Patent No. 6,648,930 on November 18, 2003. U.S. Patent No. 6,648,930 contains a single claim, which is directed to a biodiesel comprising corn oil produced by the extraction of the oil from whole high oil corn. As the claims in U.S. Patent No. 6,648,930, as issued, are not related to a corn meal or a feed containing corn meal, the double patenting rejection appears to be moot.

Copending U.S. Patent Application No. 10/422,295 currently contains claims directed only to a method for processing whole high oil corn. A copy of the currently pending claims in U.S. Patent Application No. 10/422,295 is enclosed for the Examiner's convenience. As the current claims in copending U.S. Patent Application No. 10/422,295 are not related to a corn meal or a feed containing corn meal, the double patenting rejection appears to be moot.

U.S. Patent No. 6,723,370 contains claims directed to a corn meal remaining after the extraction of oil from whole high oil corn and for a method of processing the whole high oil corn. The claims do not teach or suggest a feed ration or food product containing corn meal, nor does it claim the inclusion of another nutrient in the corn meal. As a feed ration or food product clearly is not the sole product that can be made from corn meal (see specification at, for example, page 10, line 14 through page 11, line 12), a feed ration or food product produced from the corn meal is not obvious. As such, the double patenting rejection should be withdrawn.

*Discussion of the Obviousness Rejections*

*(A) U.S. Patent Application Nos. 09/927,836 and 10/422,295 and U.S. Patent No. 6,723,370*

According to the Examiner, copending U.S. Patent Application Nos. 09/927,836 and 10/422,295 and U.S. Patent No. 6,723,370 disclose a corn meal and a feed containing corn meal but differ from the present invention in that these references lack the suggestion of the inclusion of another nutrient. The Examiner contends that the inclusion of another nutrient would be obvious in view of Morrison.

The Examiner asserts that copending U.S. Patent Application Nos. 09/927,836 and 10/422,295 and U.S. Patent No. 6,723,370 would be considered prior art to the present pending application under 35 U.S.C. § 102(e).

Copending U.S. Patent Application Nos. 09/927,836 (now U.S. Patent No. 6,648,930) and 10/422,295 and U.S. Patent No. 6,723,370 all claim priority to the current application. The present application claims priority to U.S. Patent Application No. 09/249,280, now U.S. Patent No. 6,313,328, which was filed February 11, 1999. As such, copending U.S. Patent Application Nos. 09/927,836 (now U.S. Patent No. 6,648,930) and 10/422,295 and U.S. Patent No. 6,723,370 have the same effective filing date as the present application (*i.e.*, February 11, 1999), and therefore, cannot be considered prior art to the instant application. Accordingly, the rejection under 35 U.S.C § 103(a) in view of these references should be withdrawn.

*(B) Watson and Morrison*

According to the Examiner, Watson discloses high oil corn, the concept of using it in animal feed, and various methods of processing it. The use of high oil corn in place of regular corn allegedly would have been obvious to one of ordinary skill in the art. The Examiner further contends that Morrison teaches the use of corn meal and other nutrients in feed and thus, it would have been obvious to combine the disclosures of Watson and Morrison and arrive at the present invention.

Watson discloses milling corn into meal, following degerming of the corn. The germ is then extracted for oil, while the endosperm is ground for meal and other products. Claims 1-25 and 73 of the current application require that the oil is extracted from *whole* corn, not just the germ. Since the separation of the germ from the endosperm is standard practice in corn milling (see specification at, for example, page 1, line 9 through page 2, line 4), it cannot be said that Watson renders the current claims obvious. In addition, the corn meal remaining after extraction of oil from whole corn has different characteristics than that produced by

conventional methods and is more desirable for use in feed products (see specification at, for example, page 18, line 25 through page 21, line 5).

Morrison discloses the use of corn meal in animal feeds and the use of specific nutrients in these feeds. Morrison does not state the use of *whole* corn extracts, which are required by the pending claims. Therefore, even if, for the sake of argument, the disclosures of Watson and Morrison were combined, one of ordinary skill in the art would not arrive at the present invention. Since the cited references do not teach all of the elements of the pending claims, it cannot be said that claims 1-25 and 73 are obvious in view of these references, and the rejection under 35 U.S.C § 103(a) should be withdrawn.


*Information Disclosure Statement*

Applicants acknowledge receipt of the initialed PTO-1449 forms for the Information Disclosure Statement and First and Second Supplemental Information Disclosure Statements, submitted on January 3, 2001, June 6, 2001, and February 12, 2002, respectively. Third and Fourth Supplemental Information Disclosure Statements were submitted on December 11, 2002, and September 16, 2003, respectively, and which cite references AI-BI. Applicants hereby request that the Examiner consider references AI-BI and return to applicants the initialed PTO-1449 forms.

*Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

  
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